

**REMARKS**

Claims 51-88 are all the claims presently pending in the application.

Claims 1-51 and 89-98 are canceled without prejudice or disclaimer as being directed to a non-elected invention.

While Applicant believes that all of the claims are patentable over the cited references, to speed prosecution and allowance of the claims, claim 51 has been amended to define more clearly and particularly the features of the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 51-88 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

This rejection is respectfully traversed in the following discussion.

**I. THE REJECTION UNDER 35 U.S.C. § 112**

Claims 51-88 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants respectfully disagree for at least the following reasons.

Contrary to the Examiner's position, Applicants respectfully submit that Applicants have complied with all of the requirements for establishing the enablement of the claimed invention.

Applicants note that, as ample case law has held, the test for enablement is whether one of ordinary skill in the art could practice (e.g., make and use) the invention (e.g., the claimed invention), without undue experimentation.

Applicants submit that the ordinary skilled artisan could certainly make and use the claimed invention of an image pick-up information transmitting system after a thorough reading of the specification with reference to the drawings. Therefore, this rejection is respectfully traversed.

A. First, Applicants respectfully submit that a *prima facie* case has not been established by the Examiner.

It is noted that the Examiner should identify what information is missing and why one skilled in the art could not supply the missing information without undue experimentation (e.g., see M.P.E.P. § 2164.04 and § 2164.06(a)).

In this case, the Examiner merely states that certain information is missing. However, the Examiner has not established the specific reasons why one of ordinary skill in the art could not make and use the claimed invention, which is directed to an image pick-up transmitting system, without undue experimentation.

That is, even assuming *arguendo* that such information is not described in the original disclosure, the Examiner has not explained why one of ordinary skill in the art could not make and use the claimed invention, without such allegedly missing information, without undue experimentation.

Instead, the Examiner states that:

*The claims require a selecting device for selecting "a desired function file name showing a desired function" on the basis of the displayed directories which have been passed from an information processing device to an image information receiver through a communication device, wherein the directories have*

*function file names registered therein "indicating at least a function for picking up an image," further wherein "the function file names are classified under at least one of parameters indicating image pick-up conditions and parameters indicating the properties of an image to be transmitted to the image information receiver through the communicating device."*

(see Office Action at page 4, third paragraph).

The Examiner alleges that one reasonably skilled in the art could not make and use:

*an information processing having a memory with a root directory structure that registers function files names correspond (sic) to function files such that each function file indicates a function for picking up an image, wherein the function file names are classified under parameters indicating image pick-up conditions and properties of an image to be transmitted to the image information receiver.*

The Examiner alleges that:

*...according to page 24, line 23, - page 27, line 21, and page 34, lines 14-27, of the specification, function files are given names similar to image files (e.g., shoot.jpg and lastshot.jpg) and correspond to a function the camera is supposed to perform when such a file is selected.*

*However, in the above sections of the specification, there was no indication as how the function files are generated or how the actual information stored in such a file causes the image pickup device to perform certain operations.*

*For instance, there is no indication as to the relationship between the other JPEG compressed image files (e.g., Dscf0001.jpg) and the function files and certainly no indication as to the relationship between typical camera commands (e.g., from the shutter button 20) and the function files.*

*An adequate disclosure of such an information processing device should detail all necessary components, features, and methods required for generating and using the function files as recited in the claims. (see M.P.E.P. § 2164.06(a)).*

However, the above comments by the Examiner merely state that certain information is missing. However, the Examiner has not established the specific reasons why one of ordinary skill in the art could not make and use the claimed invention, which is directed to an image pick-up transmitting system, without undue experimentation.

That is, even assuming *arguendo* that such information is not described in the original disclosure, the Examiner has not explained why one of ordinary skill in the art could not make and use the claimed invention, without such allegedly missing information, without undue experimentation.

Clearly, the ordinarily skilled artisan in this art would not need every detail of how files (such as function files) are generated or how information stored in a file causes a device to perform a certain operation, in order to make and use the invention, without undue experimentation. Indeed, the ordinarily skilled artisan clearly would know and understand how to generate a file and how a device performs an operation based on information stored in a file.

The Examiner has not explained why the ordinarily skilled artisan would not know and understand how files (such as function files) are generated or how information stored in a file causes a device to perform a certain operation.

It is incumbent on the Examiner to identify what information is missing and why one skilled in the art could not supply the missing information without undue experimentation (e.g., see M.P.E.P. § 2164.04 and § 2164.06(a)). Applicants respectfully submit that the Examiner's conclusory statements do not meet the basic requirements for establishing a *prima facie* case of lack of enablement.

Moreover, the Examiner's reasoning above appears to be directed to the features of claims 1 and 67. That is, the Examiner has not explained why independent claim 1

alone, or for that matter, many of the other dependent claims, would not be enabled to the ordinarily skilled artisan.

Applicants note that, if claims 51-88 are rejected under 35 U.S.C. § 112, first paragraph, as not being enabled, the Examiner properly should explain the reasoning for the rejection of each of the allegedly non-enabled claims, particularly independent claim 1, not merely the features of claim 67 (i.e., claim 1+67).

For at least the foregoing reasons, Applicants respectfully submit that a *prima facie* case has not been established by the Examiner.

B. Secondly, even assuming that a *prima facie* case was made that one of ordinary skill taking the present invention as a whole would not have been able to make and use “*an image pick-up information transmitting system*” without undue experimentation, to overcome a *prima facie* case of lack of enablement, Applicant must demonstrate by argument and/or evidence that the disclosure, as filed, would have enabled the claimed invention for one skilled in the art at the time of filing (see M.P.E.P. § 2164.05).

Applicants submit that the specification of the present application clearly describes with sufficient detail, so as to enable one of ordinary skill in the art to make and use the claimed invention. Applicants specifically identify and explain for the Examiner below the corresponding description in the original specification of the disputed claimed structures, thereby clearly rebutting each of the Examiner’s comments.

With respect to the Examiner’s comments regarding the relationship of the claims features to other JPEG compressed image files, it is noted that the claims of the present

application must be enabled. Thus, comments which are not directed to the elements of the claimed invention are not germane to the determination of enablement of the claims.

It is also noted that the Examiner appears to have mischaracterized the language of the claims, which may explain some of the Examiner's misunderstanding of the invention.

For example, the Examiner states that:

*The claims require a selecting device for selecting "a desired function file name showing a desired function" on the basis of the displayed directories which have been passed from an information processing device to an image information receiver through a communication device, wherein the directories have function file names registered therein "indicating at least a function for picking up an image," further wherein "the function file names are classified under at least one of parameters indicating image pick-up conditions and parameters indicating the properties of an image to be transmitted to the image information receiver through the communicating device."*

(see Office Action at page 4, third paragraph).

It is noted, however, that claim 1 clearly recites, *inter alia*, that the "information processing device comprises: an image pick-up device...; a first communication device...; a display...; and a selecting device".

In comparison, the Examiner appears to characterize the selecting device and the communicating device as being separate parts from the information processing device, instead of the information processing device "comprising" such devices, as claimed.

Again, claim 1 clearly recites, *inter alia*, that the "information processing device comprises: an image pick-up device...; a first communication device...; a display...; and a selecting device".

Turning to the specification and drawings, Applicants submit that one of ordinary skill in the art could practice (e.g., make and use) the invention, without undue experimentation.

For example, contrary to the Examiner's position, the specification and drawings of the present invention clearly provide a detailed description of the invention, including how the function files are generated, how the actual information stored in the files causes the image pickup device to perform the operations, how the camera operates, and how the function files are used (e.g., see specification at page 12, lines 4-17; page 13, lines 13-28; page 14, line 17 to page 15, line 2; page 15, lines 13-26; page 17, line 28 to page 19, line 3; page 22, line 9 to page 23, line 16; page 24, lines 8-16; page 24, line 17 to page 27, line 21; see also page 29 Table 1; see also Figures 3, 6, 8-11, 14, and 15).

Moreover, Applicant submits that the dependent claims themselves, when considered as a whole in view of the specification and drawings, clearly identify the alleged missing elements of the claims (e.g., see claims 52-88).

In light of the specific examples in the original disclosure, Applicants submit that the ordinarily skilled artisan could certainly make and use the claimed invention of an image pick-up information transmitting system after a thorough reading of the specification with reference to the drawings. In other words, one of ordinary skill in the art could practice (e.g., make and use) the invention, without undue experimentation.

Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

## **II. FORMAL MATTERS**

### **Objection to Title**

The Title has been amended above to obviate the objection.

### **Drawings Objections**

The Examiner also objects Figure 14 for spelling errors. Figures 10, 14, and 15 are amended herewith to correct the spelling errors. It is noted that S102 properly states “set to image obtaining menu”, as set forth in the specification at page 32, lines 12-16).

The Examiner also objects to the drawings because Step S110 (at page 33, line 4) is not shown in the drawings. It is noted that Figure 14 is corrected to show “S110 Folder List Information” (instead of S108), in accordance with page 33, line 4 of the specification, thereby obviating this objection.

### **Claim Objections**

The Examiner also objects to claim 51. Claim 51 is amended herewith to obviate this objection, in accordance with the Examiner’s suggestion.

### **IDS Form PTO 1449**

It is noted that, for some reason, the Examiner did not include a signed and initialed form PTO 1449 for the Information Disclosure Statement filed on April 17, 2001, which cited two (2) Japanese applications.

However, the Information Disclosure Statement’s fully complied with M.P.E.P. § 609 and 37 C.F.R. §§ 1.97-1.99.

Hence, the Examiner is requested to consider and initial all of the references cited on the PTO-1449 Form for the Information Disclosure Statements filed on April 17, 2001. For the Examiner’s convenience, a copy of the PTO-1449 Form is resubmitted herewith.



### III. CONCLUSION


In view of the foregoing, Applicant submits that claims 51-88, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 6/14/06

  
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**AMENDMENTS TO THE DRAWINGS:**

The Office Action objects to Figure 14 for minor spelling errors. Figure 14 is amended herewith in accordance with the Examiner's suggestion.

Figures 10 and 15 also are amended herewith to correct minor spelling errors.

Therefore, the Examiner is requested to enter and consider the replacement sheets and annotated sheets showing changes made.

Attachments:

Replacement Sheets ( 3 )

Annotated Sheets Showing Changes ( 3 )



FIG. 10

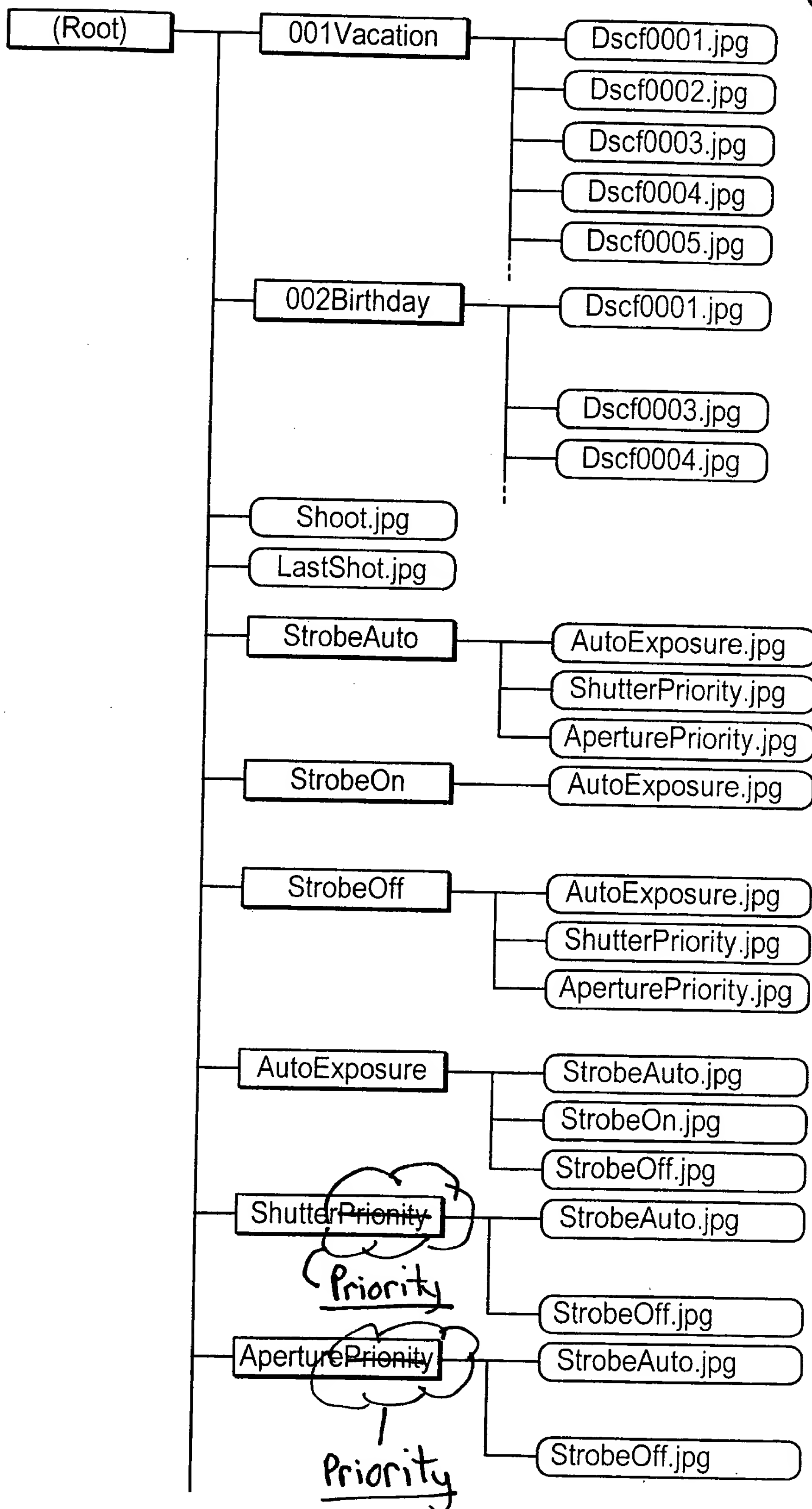


FIG. 14

